

REMARKS/ARGUMENTS

Claims 1-26 are pending in the present application. Claims 1, 8, 11, and 17 are independent claims. Claims 19-26 are new. The Examiner is respectfully requested to reconsider his rejections in view of the following Remarks.

Rejection Under 35 U.S.C. § 103

Nozaki/Tachibana Rejection

Claims 1, 3, 4, 8, 11, 13, 14, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0193610 to Nozaki et al. (hereinafter Nozaki) in view of Japanese Patent Document No. JP 9212620 to Tachibana et al. (hereinafter Tachibana). This rejection is respectfully traversed.

Prior Art Fails to Teach or Suggest Each Claimed Feature

M.P.E.P. § 2143.03 sets forth the following requirements for a proper rejection under 35 U.S.C. § 103:

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)."

Applicant respectfully submits that the prior art fails to provide a teaching or suggestion of all of the features in the claimed invention.

Independent claim 1 recites, as part of the image selecting apparatus, a selecting unit whose operation results in the selection of a desired image by the apparatus. Thus, the claimed image selecting apparatus selects a desired image, which includes a desired aimed object satisfying at least one selection condition, from among a plurality of images without requiring the user of the apparatus to inspect all of the images.

In the Office Action (page 5, lines 1-2), the Examiner admits that Nozaki fails to disclose selecting an image based upon a desired aimed object. However, in page 5, lines 2-4, the Examiner asserts that Tachibana teaches, "the evaluation of an image based upon expression feature data, which reads on the desired aimed object, and the selection of one particular image from a plurality of images." Thus, it is evident that the Examiner is relying on Tachibana to disclose that an apparatus selects an image based on a desired aimed object.

However, it is respectfully submitted that the process disclosed by Tachibana teaches a method of image selection requiring that a person, who is the photographic subject,

perform selection of optimal elements. For instance, it is respectfully submitted that when Tachibana's original Japanese description is translated into English, paragraph [0015] discloses, "[t]his selection, upon a review of images presented on a monitor etc., is performed according to intention of a photographic subject etc." Applicant respectfully submits that Tachibana's description of steps S6, S8, and S9 imply that the user's selection of image data is required. (For the Examiner's convenience, a machine translation of Tachibana is provided. However, Applicant cautions that certain inaccuracies may exist in the attached machine translation.)

Therefore, it is respectfully submitted that even if Nozaki and Tachibana were combined, as proposed by the Examiner, the resultant combination would still require a user to check all of the images and select one of them, in order to obtain a desired image from among a plurality of images. Thus, Applicant respectfully submits that the Nozaki/Tachibana combination fails to teach or suggest every feature in independent claim 1. Also, it is submitted that the Nozaki/Tachibana combination fails to achieve the above-mentioned benefits obtained by the claimed invention.

At least for the reasons set forth above, it is respectfully submitted that the cited prior art fails to teach or suggest each of the features recited in claim 1.

Applicant further submits that independent claim 8 recites a camera, which includes a feature similar to that described above in connection with independent claim 1. Independent claim 11 also recites a method in an apparatus, which includes a similar feature. Furthermore, independent claim 17 recites a program stored on a medium that includes a similar feature. Thus, Applicant respectfully submits that the cited prior art fails to teach all of the claimed features in claims 8, 11, and 17, for reasons similar to those set forth above in connection with claim 1.

Nozaki and Tachibana Not Combinable

Furthermore, Applicant respectfully submits that the proposed combination of Nozaki and Tachibana is improper. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, the Examiner is required to provide a teaching or motivation for combining the references, either explicitly or implicitly in the prior art or in the knowledge generally available to one of ordinary skill in the art. See MPEP § 2143.01.

Applicant respectfully submits that the Examiner has failed to provide such teaching or motivation. Instead, the Examiner merely states that one of ordinary skill in the art would combine Nozaki and Tachibana "to obtain the best quality image of a human face." Applicant respectfully submits that such a statement does not constitute motivation whose source is either the prior art references, or the knowledge generally available to those of ordinary skill in the art. Instead, the statement merely a broad conclusory statement, which is insufficient to establish a *prima facie* case of obviousness. See In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Applicant also respectfully submits that the combination of Nozaki and Tachibana is improper because the Examiner's proposed modification of Nozaki would change its principle of operation. As set forth in Section 2143.01, the eighth paragraph of the MPEP:

If the proposed modification or combination of the prior art will change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.

The Applicant respectfully submits that the proposed modification by the Examiner of the Nozaki in view of Tachibana would change Nozaki's principle of operation. Nozaki is merely

concerned with obtaining an image, which was taken under the best shooting conditions. Thus, changing Nozaki to evaluate images based on expression feature data, as allegedly taught by Tachibana, is not proper § 103(a).

Claims Not Rendered Obvious

At least for the reasons set forth above, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to independent claims 1, 8, 11, and 17. Thus, it is respectfully submitted that claims 1, 8, 11, and 17 are allowable over Nozaki and Tachibana. Furthermore, it is respectfully submitted that claims 3, 4, 13, 14, and 18 are allowable at least by virtue of their dependency on claims 1 and 11. The Examiner is, therefore, respectfully requested to reconsider and withdraw this rejection.

Nozaki/Tachibana/Mihara Rejection

Claims 2 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nozaki in view of Tachibana, and further in view of U.S. Patent Publication No. 2002/0126879 to Mihara et al. (hereinafter Mihara). Applicant respectfully submits that Mihara fails to remedy the deficiencies of Nozaki and Tachibana, as set forth above in connection with independent claims 1 and

11. Thus, it is respectfully submitted the claims 2 and 12 are allowable at least by virtue of their dependency on claims 1 and 11. Accordingly, the Examiner is respectfully requested to reconsider and withdraw this rejection.

Nozaki/Tachibana/Marugame Rejection

Claims 5-7, 15, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nozaki in view of Tachibana, and further in view of U.S. Patent No. 6,226,396 to Marugame (hereinafter Marugame). It is respectfully submitted that Marugame fails to remedy the deficiencies of Nozaki and Tachibana, as set forth above in connection with independent claims 1 and 11. Thus, Applicant respectfully submits that claims 5-7, 15, and 16 are allowable at least by virtue of their dependency on claims 1 and 11. The Examiner is respectfully requested to reconsider and withdraw this rejection.

Nozaki/Tachibana/Mihara/Yoshigahara Rejection

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Nozaki in view of Tachibana and Mihara, and further in view of U.S. Patent Publication No. 2002/0085747 to Yoshigahara et al. (hereinafter Yoshigahara). Applicant respectfully submits that both Mihara and Yoshigahara fail to

remedy the deficiencies of Nozaki and Tachibana, as set forth above in connection with independent claim 8. Accordingly, it is respectfully submitted the claim 9 is allowable at least by virtue of its dependency on claim 8. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

Nozaki/Tachibana/Nonweiler Rejection

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Nozaki in view of Tachibana, and further in view of U.S. Patent No. 6,262,778 to Nonweiler et al. (hereinafter Nonweiler). It is respectfully submitted that Nonweiler fails to remedy the deficiencies of Nozaki and Tachibana, which are discussed above in connection with independent claim 8. Therefore, it is respectfully submitted the claim 10 is allowable at least by virtue of its dependency on claim 8. Applicant respectfully requests the Examiner to reconsider and withdraw this rejection.

New Claims

New claims 19-26 have been filed in the present application. Applicants respectfully submit that these new claims do not add any new matter to the present application.

In particular, Applicant respectfully submits that the specification provides full support for the features of claim 19, 21, 23, and 25 in, *inter alia*, page 11, line 16 - page 12, line 34. This portion of the specification recites discloses examples of selection conditions that relate to expressions of an aimed object, including: person is blinking; person's eyes are not red-eyed; person is looking at the camera; person is smiling, etc.

Furthermore, Applicant respectfully submits that the features of new claims 20, 22, 24, and 26 are supported throughout the specification.

Conclusion

Entry of this Amendment After Final is respectfully requested. In view of the above remarks, it is believed that the claims clearly distinguish over the patents relied on by the Examiner, either alone or in combination. Thus, the Examiner is respectfully requested to reconsider the outstanding claim rejections and issue a Notice of Allowance in connection with the present application.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Jason W. Rhodes (Reg. No. 47,305) at the telephone number of the undersigned in order to discuss the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.


Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

Michael K. Mutter, #29,680

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000


MKM/JWR

Attachment: Machine Translation of JP 09-212620